

REMARKS

The Office Action dated March 21, 2006, has been received and carefully considered. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. **THE ANTICIPATION REJECTION OF CLAIM 1**

On page 4 of the Office Action, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent No. 6,343,327). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id.. “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id..

Although Applicant does not agree with the pending rejections, Applicant has nonetheless amended independent claim 1 to incorporate recitations not disclosed by any of the cited references. Claim 1, for example, has been amended to recite the limitations of independent claims 15 and 28: “chang[ing] a document delivery designation for an intended

recipient of a failed email *so that an intended recipient will no longer receive electronic documents.*

In connection with the obviousness rejection of claims 15 and 28, the Examiner concedes that Daniels does not teach changing the stored document delivery designation so that future documents are delivered to the intended recipient only non-electronically. However, the Examiner alleges that Reilly teaches forwarding (via forwarding list server 300, Fig. 2) a message to a new address if the old address fails (col. 2, lines 29-32; col. 4, lines 10-15 and throughout) including automatically forwarding to the new address in the future (see Abstract, wherein the sending entity can have its database automatically changed to route to the new address; col. 3 lines 103; col. 32-35, wherein the forwarded address can be a physical address; col. 4, lines 60-63, wherein “thereafter automatically sending” to the new address). The Examiner further alleges that it would have been obvious to one of ordinary skill in the art that the forwarding of Daniels could be automatically changed and therefore sent to the new physical address in the future, thus adding the beneficial feature of Reilly to the failed email management system of Daniels. The motivation for doing so would have been to not keep trying to email the dead email address and then getting errors and re-routing to the user non-electronically and to have it get to the user faster and with less unnecessary steps.

However, Applicant respectfully submits that Reilly does not teach or suggest the specific step of “chang[ing] a document delivery designation for an intended recipient of a failed email *so that the intended recipient will no longer receive electronic documents.*” Rather, Applicant respectfully submits that Reilly merely discloses systems and methods that automatically determine if the recipient of electronic mail that is unknown at the receiving server

has left a "forwarding address." The following excerpts of Reilly -- all cited by the Examiner -- demonstrate Reilly's deficiency:

The receiving server thus checks its database of electronic mail users and validates the electronic mail recipient's name (the part of the electronic mail address before the @ sign).

See, Col. 2, lines 29-32.

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According to an aspect of the invention, a method is provided for automatically resending an electronic message originally sent to a receiving user at a first address that is now invalid to a second address for the receiving user, wherein the second address has been registered with a forwarding server.

See, Col. 4, lines 10-15.

* * * * *

The present invention provides systems and methods for automatically determining if the recipient of electronic mail that is unknown at the receiving server has left a "forwarding address" with another server (the "forwarding listserver"), thereby allowing either the receiving server, the sending server, or the sending user (e.g., computer system), or any other party to the communication, to automatically send the electronic mail content to the (new) correct address.

See, Col. 2, line 63 - Col. 3, line 3.

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Additionally, other forwarding data can be stored, such as a new postal mail address, new phone number, and other items of data. This data could be promulgated based on a variety of criteria, or be available to the Internet at large.

See, Col. 3, lines 32-35.

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The method also typically includes the steps of returning the second address to the second domain, and thereafter automatically sending the electronic message to the second address.

See Col. 4, lines 60-63.

* * * * *

Systems and methods for automatically determining if the recipient of electronic mail that is unknown at the receiving server has left a "forwarding address" with a forwarding address server, thereby allowing either the receiving server, the sending server, or the sending user (computer system), or any other party to the communication, to automatically send the electronic mail content to the correct new address. In addition to this automatic "forwarding", the sending user is notified as to the new electronic mail address so as to allow the sending user to update manually, or automatically, the user's individual database of electronic mail addresses.

See Abstract.

Applicant respectfully submits that -- as evidenced by the above excerpts -- Reilly does not teach or suggest any feature or functionality that "chang[es] a document delivery designation for an intended recipient of a failed email so that the intended recipient will no longer receive electronic documents." In particular, Applicant respectfully submits that Reilly does not teach or suggest any feature or functionality that ensures that an intended recipient will no longer receive electronic documents. Merely updating the user's individual database -- as Reilly is alleged to be able to do -- does not comprise the specific step of "chang[ing] a document delivery designation for an intended recipient of a failed email so that the intended recipient will no longer receive electronic documents." as required by independent claim 1. In fact, Applicant respectfully submits that there is no teaching or suggestion in Reilly any feature or functionality that changes any designation that has the consequence of ensuring that the intended recipient will no longer receive electronic documents.

Applicant respectfully submits that none of the other cited references make up for Daniels' deficiency in this regard. Quine, for example, merely discloses the use of alternate means of communication to deliver documents to recipients. The other references -- Bruce,

Seestrom and Smith -- were cited for different reasons, and thus fail to make up for Daniels and Quine, and Reilly's deficiencies. Accordingly, Applicant respectfully submits that none of the cited references teach or suggest any feature or functionality that changes a document delivery designation for an intended recipient of a failed email *so that the intended recipient will no longer receive electronic documents.* Claims 15 and 28 include recitations that are similar to claim 1 and thus should be allowable for at the reasons set forth above.

Claims 2-10, 12-14, 16-22, 24-27, 29-33, and 35-41 are dependent upon independent claim 1, 15 or 28. Thus, since independent claim 1, 15 and 28 should be allowable as discussed above, claims 2-10, 12-14, 16-22, 24-27, 29-33, and 35-41 should also be allowable at least by virtue of their dependency on independent claim 1, 15 or 28. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 39 recites the system of claim 1 wherein changing a document delivery designation comprises changing a stored document delivery designation so that future documents are delivered to the intended recipient only non-electronically. Applicant respectfully submits that none of the cited references -- alone or in combination -- teach or suggest the system of claim 1 wherein changing a document delivery designation comprises changing a stored document delivery designation so that future documents are delivered to the intended recipient only non-electronically.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claim 1 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 2-10, 12-22, 24-33 AND 35-41

On page 6 of the Office Action, claims 2-7 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Quine (U.S. Patent No. 6,782,415). On

page 9 of the Office Action, claims 12, 13, 15, 24-26, 28, 35-37 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Reilly (U.S. Patent No. 6,427,164). On page 15 of the Office Action, claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, Quine, and further in view of Smith (U.S. Patent No. 6,385,655). On page 16 of the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Reilly, further in view of Bruce (U.S. Patent No. 6,741,724), and further in view of Seestrom (U.S. Patent No. 6,647,385). On page 17 of the Office Action, claims 16-20, 22, 29-31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Reilly, further in view of Quine. On page 18 of the Office Action, claims 21 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, Quine, Reilly and Smith. On page 19 of the Office Action, claims 27 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, Reilly, Bruce and Seestrom. These rejections are hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the above obviousness rejections have been overcome by the amendments and/or remarks set forth above in connection with the anticipation rejection of claim 1.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2-10, 12-22, 24-33 and 35-41 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

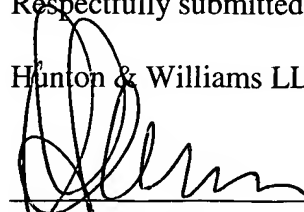
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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